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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593
5514	7590	08/22/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/903,743

Applicant(s)

LONG ET AL.

Examiner

CESAR B. PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-4, 7, 9-12, 27, 29, 32-33, 42, 44-48, 50-51, and 53-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4, 7, 9-12, 27, 29, 32-33, 42, 44-48, 50-51, and 53-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to:
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE amendment filed on 6/6/2006.

This action is made Non-Final.

2. In the amendment, claims 1, 28, 31, 38, 43, 49, and 52 have been canceled. Claims 58-59 have been added. Claims 3-4, 7, 9-12, 27, 29, 32-33, 42, 44-48, 50-51, and 53-59 are pending in the case. Claims 27, 29, and 54-57 are independent claims.

3. The rejections of claims 1, 3-4, 7, 9-12, 27-29, 31, 38, 42-57 rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96), in view of Savitzky et al, hereinafter Savitzky (Pat. # 6,012,083, 1/4/2000, filed on 9/24/1996), have been withdrawn as necessitated by the amendment.

4. The rejections of claims 32-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Savitzky, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94), have been withdrawn as necessitated by the amendment.

Drawings

5. The drawings filed on 5/11/2004 have been accepted by the Examiner.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-4, 7, 9-12, 27, 29, 42, 44-45, 50-51, and 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96), in view of Savitzky et al, hereinafter Savitzky (Pat. # 6,012,083, 1/4/2000, filed on 9/24/1996), further in view of King et al, hereinafter King (Pat. # 5,956,737, 9/21/1999, filed on 9/9/1996).

Regarding independent claim 42, Nehab teaches the creation of a personalized document. This document is created by collating and arranging various stand alone web pages of different newspapers articles into a single linear or continuous printable document. A "site driver" is used for monitoring web page sections accessed, and url addresses or commands entered by a user into a profile editor-- *second application operating on a local machine*-- while navigating a network web pages. The driver records the web sites accessed in a log, as urls or as rules— *compiling a list of documents accessed by the second application*--, for the later retrieval, and formatting these documents into a single linear document of documents similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, fig.1,4). In other words, every time a new web site is accessed, it is detected and placed on the list --*detecting whether the compiled*

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list is updated due to an access of the second application; Nehab fails to explicitly disclose: *second application operating independently of the first application on the local machine to identify the plurality of documents accessed by the second application.* However, Savitzky teaches an independent agent for providing a history of all the documents accessed by client(s), which can be located anywhere on a network where the agent is reachable by multiple browsers (col.3, lines 45-67, col.12, lines 16-32, col.10, lines 51-56, abst., fig.1). In other words, if the user has Netscape, and Internet Explorer browsers on his computer, the agent would be located on the computer, separate or operating independently from the browsers without interfering with the browsing experience, so as to allow the browser to navigate the webpages. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, and Savitzky, and have monitored the second application--client, because Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing an agent that is flexible, and does not depend or is tied down to either the client or server, and that can be quickly accessed by the browsers locally.

Further, Nehab teaches the retrieving, and formatting of the various web pages using the address/location—*fetching, in response to said detecting step detecting that the compiled list is updated, the plurality of accessed documents in the compiled list; formatting the plurality of fetched and updated documents into a printable document in response to said detecting step detecting that the compiled list is updated, and/or articles of different newspapers into a single printable document, where the various newspapers are contiguously laid out* (c.3, L.15-c.4,L.67, c.9,L.40-63).

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Furthermore, Nehab fails to explicitly disclose: *displaying the printable document formatted in said formatting step in a print preview display to represent a document which includes pages printable by a printer output device. wherein the print preview display is generated in accordance with changes to print settings of the printer output device.* However, King teaches if a document is formatted to be printed onto a certain media, such as paper, the system will display the page media onto a computer screen via a print preview option (col.35, lines 7-35, fig.1A-D). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, Savitzky, and King, because of all the reasons found in King, including (col. 8, lines 34-67), and Savitzky teaches allowing authors to create a document, and reformat it to fit a variety of media based on changes made to the content or design of the document (col. 2, lines 42-67). This provides the benefit of automatically, interactively, and flexibly create and edit printable documents.

Regarding claim 3, which depends on claim 42, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.9,L.40-62). Nehab fails to explicitly disclose:*the printable document is updated upon new pages being accessed by the second application.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have updated the document, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and

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interactively reproducing user's selection of hyperlinks, while avoiding time consuming manual update of the document.

Regarding claim 4, which depends on claim 42, Nehab teaches a tracking program for the monitoring of url addresses or commands entered by a user while navigating a network web pages (c. 8, L.34-67)-- *....said steps are performed in a background mode relative to the user's access to the documents.*

Regarding claim 7, which depends on claim 42, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16, L.1-67).

Regarding claim 9, which depends on claim 42, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15, L.20-c.16, L.67)--*....the printable document comprises a table of contents listing each document*

Regarding claim 10, which depends on claim 42, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --*....an index of at least one reference ...* (c.6, L.58-c.7, L.67, and c.15, L.20-c.16, L.67).

Regarding claim 11, which depends on claim 10, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink cross-references to an index -
-.... *each reference in the printable document is tagged with a cross reference to a corresponding entry* ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink references of each article represented in the formatted document *said index comprises all references of each document*--(c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first application in a local computer*, of a personalized document by collating and arranging various web pages, from websites--*sources*, of different newspapers articles into a single linear or continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 1, 4, 9A).

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 42, and is similarly rejected.

Claims 44-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 42, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer readable medium for storing the steps found in claim 42, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation, by a stand alone, of a personalized document. This document is created by collating and arranging various stand alone web pages of different newspapers articles into a single linear or continuous printable document. A “site driver” is used for monitoring web page sections accessed, and url addresses or commands while navigating a network web pages. The driver records the web site accessed in a log, as urls or as rules, for the later retrieval—*fetching each document selected from the list--*, and formatting into a single linear document of documents similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, c.9,L.62-c.10,L.21; fig.1,4). Nehab fails to explicitly disclose: *displaying the list of the plurality of documents*. However, King teaches if a document is formatted to be printed onto a certain media, such as paper, the system will display the page media onto a computer screen via a print preview option (col.35, lines 7-35, fig.1A-D). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, Savitzky, and King, because of all the reasons found in King, including (col. 8, lines 34-67), and Savitzky teaches allowing authors to create a document, and reformat it to fit a variety of media based on changes made to the content or design of the document (col. 2, lines 42-67). This provides the benefit of automatically, interactively, and flexibly create and edit printable documents.

Regarding claim 50, which depends on claim 48, Nehab teaches the creation of a personalized document by retrieving, collating—*compiling--* and arranging various web pages of

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different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Claims 51, 53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48, and 50, and therefore are similarly rejected.

Claim 54 is directed towards a method for forming the print list for found in claim 42, and is similarly rejected.

Claim 55 is directed towards an apparatus for carrying out the steps found in claim 42, and is similarly rejected.

Claim 56 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 42, and is similarly rejected.

Claim 57 is directed towards a computer apparatus for carrying out the program found in claim 42, and is similarly rejected.

Regarding claim 58, which depends on claim 42, Nehab teaches the creation of a personalized document by retrieving, collating and arranging the various web pages, listed in a

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log, of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Regarding claim 59, which depends on claim 42, Nehab teaches the creation of a personalized document by retrieving, collating and arranging the various web pages, listed in a log, of different newspapers articles—*formatting options*-- into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

8. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Savitzky, further in view of King, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94).

Regarding claim 32, which depends on claim 42, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....maximizing the number of documents on each page.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Savitzky, King and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

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Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....determining if space exists on a page of the printable document.....if so, inserting the formatted-document.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Savitzky, King and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

Response to Arguments

9. Applicant's arguments filed 6/6/2006 have been fully considered but they are moot in light of the new rejections in response to the claim amendment. The Applicant submits that the amended claims are patentable over the prior art of record (page 18). The Applicant is directed towards the rejection of these claims in light of the newly applied rejections.

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Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

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- (571)-273-8300 (for all Formal communications intended for entry)


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PRIMARY EXAMINER
8/18/06